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REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 4-11 are pending. Claims 4 and 7- 10 have been made in response to the rejections under 35 USC 102 and 35 USC 103. Amendments to claims 4 and 7-10 are supported by the Examples in the instant specification. It is believed that no new matter has been added.

Since this amendment is being filed along with a Request for Continued Examination (RCE), no showing under 37 CFR § 1.116(b) is believed to be required.

Interview

Applicants appreciate the Examiner's time on August 3, 2005 for the telephone interview. Applicants inquired as to amending the claims by further defining the exemplified emulsifiers. The Examiner indicated that the emulsifiers were not previously presented, and therefore would require a further search and/or consideration. Therefore, no agreement was made as to the claims.

Rejections under 35 USC 102 and 35 USC 103

Claims 4-6 and 9-11 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being obvious over WO 91/18669.

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The Examiner also rejected claims 8-11 under 35 USC 103(a) as being obvious over WO 91/18669.

According to the Examiner, WO 91/18669 teaches microemulsions which have the property of being transparent or translucent. The Examiner found the reference did not make a distinction between the order of addition of the emulsifiers and co-emulsifiers, and ultimately found the sequence of adding materials or the selection of any order of the steps to be obvious in the absence of new or unexpected result.

In response to the anticipation rejection, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *In re Robertson,* 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In response to the obviousness rejection, Applicants point out that obviousness can only be established by combining or modifying the teachings of the prior art to produce the present invention where there is some teaching, suggestion, or motivation to do so either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See* MPEP §2143.01. In addition, all claim limitations must be taught or suggested. *See* MPEP §2143.03.

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Regarding the product claims, Applicants submit that WO 91/18669 contains no teaching or suggestion of a microemulsion which comprises the recited emulsifiers nor is there any teaching or suggestion of microemulsion which is prepared by a process comprising "first heating the constituents of the oil phase and constituents of the aqueous phase separately to a temperature above or within the phase inversion temperature". As indicated above, the amendments to the claims are found in the Examples of the instant specification. WO 91/18669 recites various emulsifiers at page 4 and in the examples, but there is no teaching or suggestion of the presently claimed emulsifiers. Accordingly, because WO 91/18669 neither teaches or suggests the presently claimed emulsifiers nor is there any teaching or suggestion of a microemulsion prepared by the process as instantly claimed, Applicants submit that the prior art reference neither anticipates the claims nor renders them obvious.

Regarding the process claims, Applicants submit that WO 91/18669 contains no teaching or suggestion of a process for preparing a microemulsion which comprises "first heating the constituents of the oil phase and constituents of the aqueous phase *separately* to a temperature above or within the phase inversion temperature" [Emphasis supplied]. Applicants would remind the Examiner that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *See* MPEP §2131. Moreover, to establish a *prima facie* case for obviousness, all of the claims limitations must be taught or suggested. *See* MPEP §2143.03. Applicants point out that WO 91/18669 contains no teaching of any specific

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process steps for making a microemulsion, wherein the constituents of the oil phase and the aqueous phase are heated separately. WO 91/18669 teaches mixtures which are mixed together either prior to or with heating. By way of illustration, Example 1 in WO 91/18669 shows an oil phase and an aqueous phase which mixed together at room temperature. The resultant emulsion is then heated. The instant claims require both oil and aqueous phase constituents to be heated separately. The Examples in the instant specification support this proposition. Therefore, Applicants submit that because WO 91/18669 does not teach or suggest a process comprising a "first heating the constituents of the oil phase and constituents of the aqueous phase separately to a temperature above or within the phase inversion temperature", the claims are neither anticipated nor rendered obvious.

Further on this point, Applicants refer the Examiner to the Examples in the instant specification. The Examples disclose the oil and aqueous phase constituents being heated separately to eventually form a microemulsion. These results are surprising in view of what would be expected in view of WO 91/18669. Applicants submit there is nothing in WO 91/18669 that would have suggested these results. Accordingly these data must be regarded as surprising, and therefore, unexpected, and consequently, as objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that all evidence of nonobviousness must be considered when assessing patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

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In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw these rejections. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

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ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By _____

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